Attorney Docket 08631.0007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD

DALLAS BASKETBALL LIMITED) 09-17-2003
Opposer,) U.S. Patent & TMOfc/TM Mail Rcpt Dt. #2
	Opposition No. 91156064
V.)
JOHN JACOB CARLISLE) Serial No. 76/165,865) Mark: DEEP 3 and Design
Applicant.)
)

<u>APPLICANT'S ANSWER TO NOTICE OF OPPOSITION</u>

John Jacob Carlisle ("Applicant") answers the Notice of Opposition against pending Application Serial No. 76/165,865 as follows:

Dallas Basketball Limited ("Opposer") sets forth allegations in the preamble of its Notice of Opposition. Applicant responds that Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in the preamble of the Notice of Opposition, and therefore denies them.

- 1. Since the filing of Application Serial No. 76/165,865, Applicant has moved to 15708 NE 42nd Street, Vancouver, Washington, 98682. Otherwise, Applicant admits the allegations in Paragraph 1 of the Notice of Opposition.
- 2. Applicant admits that the U.S. Patent and Trademark Office TARR database shows Opposer's Application Serial No. 76/380,739 for the mark DEEP3 was filed on March 8, 2002 for "clothing and sportswear, namely, hosiery, footwear, swimwear, underwear, briefs, pants, shirts, jeans, tank tops, jerseys, shorts, pajamas, night shirts, men's suits, sweaters, belts, ties, scarves, hats, warm-up suits, jackets,

parkas, coats, cloth bibs, headbands, wristbands, aprons, boxer shorts, slacks, caps, ear muffs, gloves, and mittens" in International Class 25. Applicant lacks sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 2 of the Notice of Opposition, and therefore denies them.

- 3. Applicant admits that the U.S. Patent and Trademark Office TARR database currently shows that Applicant's prior pending Application Serial No. 76/165,865 for the mark DEEP 3 was abandoned on January 12, 2002, and that Applicant's Petition to Revive was granted on September 29, 2002. Applicant also admits that the U.S. Patent and Trademark Office has refused Opposer's DEEP3 application on the ground that it is confusingly similar to Applicant's DEEP 3 application. Otherwise, Applicant lacks sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 3 of the Notice of Opposition, and therefore denies them.
- 4. Applicant denies Applicant abandoned the DEEP 3 mark and that Applicant's DEEP 3 mark was not used in commerce before Opposer filed its DEEP3 application. Applicant also denies that Opposer acted with due diligence. Applicant denies Opposer filed its DEEP3 application in good faith, as well as denies Opposer prepared to use the DEEP3 mark in good faith. Applicant further denies Opposer has been or will be further damaged by the U.S. Patent and Trademark Office's refusal to register Opposer's pending DEEP3 application on the grounds of confusing similarity or otherwise, or that Opposer has been or will be further damaged by having to cease with its present infringing use of Applicant's DEEP 3 mark. Applicant admits Opposer will be denied registration of its DEEP 3 mark when Applicant's DEEP 3 mark registers.

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Otherwise, Applicant lacks sufficient information to form a belief as to the truth or falsity of the remaining allegations in Paragraph 4 of the Notice of Opposition, and therefore denies them.

5. Denied.

AFFIRMATIVE DEFENSES

- 6. The Notice of Opposition fails to state a claim upon which relief may be granted. Opposer lacks a factual basis on which to file this opposition. Opposer lacks a legal basis on which to file this opposition.
- 7. Opposer acted in bad faith and with unclean hands for at least the following reasons:
 - (a) Opposer knew that Applicant used its DEEP 3 mark in commerce in connection with the identified goods before filing this opposition. Applicant provided documentary evidence to Opposer proving Applicant's use of the mark in commerce before Opposer filed the opposition. Nevertheless, Opposer filed the Notice of Opposition alleging that Applicant lacked a bona fide intent to use the mark in commerce and Opposer continues to use the DEEP3 mark in willful violation of Applicant's prior rights.
 - (b) Opposer knew of Applicant's prior filed application and prior rights in the DEEP 3 mark before filing Application Serial No. 76/380,739 for the mark DEEP3 on March 8, 2002, and before making any preparations for or launching any products under the mark DEEP3, and thus proceeded in willful and reckless disregard of Applicant's prior pending application and trademark rights.

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(c) Opposer's DEEP3 mark is identical in sound, appearance, and connotation to Applicant's DEEP 3 mark, and the goods offered in connection with the parties' respective marks are also identical and/or closely related. Opposer's DEEP3 mark so resembles Applicant's previously used mark DEEP 3 as to be likely to cause confusion, or to cause mistake, or to deceive. The U.S. Patent and Trademark Office has refused Opposer's DEEP3 application on the basis of its confusing similarity with Applicant's DEEP 3 application and Opposer admits it will be denied registration of its DEEP3 mark once Applicant's DEEP 3 mark registers. Opposer's knowing use of the identical mark is likely to cause confusion, and further constitutes bad faith and willful trademark infringement and unfair competition of Applicant's trademark rights.

WHEREFORE, Applicant prays that this opposition be dismissed with prejudice, and that Applicant's mark be granted registration.

Respectfully Submitted,

Dated: September 17, 2003

Mark Sommers Linda McLeod

Montia Givens Pressey

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing APPLICANT'S ANSWER TO

NOTICE OF OPPOSITION was served on September 17, 2003, by U.S. mail, first-class

postage pre-paid, in an envelope addressed to:

Molly Buck Richard Thompson & Knight LLP 1700 Pacific Avenue Suite 3300 Dallas, Texas 75201-4693